

Examiner: A. Gupta

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The Examiner states that the inventions listed in Groups I and II do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features because the method of claim 15 can be practiced with a materially different peptide such as RGD analogs.

The Office Action further states that the application contains claims directed to more than one species of the generic inventive concept under PCT Rule 13.1, and requires that a single species be elected to which the claims shall be restricted if no generic claim is finally held to be allowable. The species identified by the Examiner are the peptides recited in claims 5, 7, 8, and 12.

Applicants provisionally elect Group I (claims 1-14), with traverse. Applicants respectfully request that the restriction requirement be reconsidered because the Examiner has not shown the existence of independent and distinct inventions in the claim groupings or that a serious burden would be required to examine all the claims. M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden.

Applicants respectfully assert that the Examiner has not shown that either of these requirements have been met, on the basis that the Examiner has shown neither that all of the claims as grouped are independent and distinct inventions nor that it would be serious burden to search and examine all of the claims together.

Specifically, all of the claims relate to the peptides, compositions, and the method of using the peptides of Group I, such that if the peptides, compositions, and method of using the

peptides of Group I are free of the prior art, then Group II would also be free of the prior art. This is because the method of delivering a chemical moiety of Group II is dependent on, and thus limited to the use of, the peptides and compositions of claims 1-14. Therefore, the method of claim 14 cannot, as asserted by the Examiner, be practiced with a materially different peptide such as a RGD analog. Thus, the claims as grouped are not directed to independent and distinct inventions.

Furthermore, applicants respectfully contend that there can be no serious burden in examining all the claims together. Examination of Groups I and II together would only require a search of one additional subclass in a single class. Broadening the search to include one additional subclass would not constitute a serious burden upon the Examiner and examining all of the claims together would eliminate the necessity of prosecuting multiple, separate, yet intimately related, applications. Thus, this criterion of M.P.E.P. § 803 as set forth above has not been satisfied, because the Examiner has not shown that it would be a serious burden to search and examine all of the claims of this invention together.

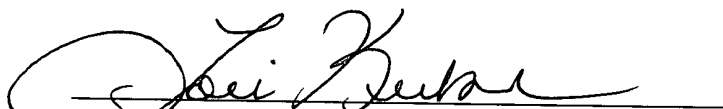
With regard to the required election of species upon the provisional election of the claims of Group I, applicants provisionally elect the following peptide, with traverse. Applicant provisionally elects the peptides recited in claim 5. The following claims of Group I are readable on this provisional species election: 1, 2, 3, and 4.

For the reasons stated above, Applicant respectfully asserts that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency

in the Patent Office and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Thus, Applicant respectfully requests that all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

A check in the amount of \$55.00 and a Request for Extension of Time are enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks Washington, D.C. 20231, on this 15th day of May, 2000.

  
Lori L. Kerber

5/15/00  
Date

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